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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/916,527 08/22/97 HONG

Y ALANEX.006A

HM22/0731  
AGOURON PHARMACEUTICALS, INC.  
PATENT DEPARTMENT  
10350 NORTH TORREY PINES ROAD  
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EXAMINER

COVINGTON, R

ART UNIT

PAPER NUMBER

1625

DATE MAILED:

07/31/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

# Office Action Summary

Application No.

09/9/6,527

Applicant(s)

Hogstad

Examiner

Covington

Group Art Unit

1625

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 5/10/01
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 13-25 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 13-25 is/are rejected.
- ☒ Claim(s) 13-25 is/are objected to.
- ☒ Claim(s) 13-25 are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

Art Unit: 1612

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 11-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Talley et al U.S. 5,482,947 taken with Marad et al U.S. 5,380,945.

The references are applied as in the last Office Action. Applicants' comments have been noted and considered with the following effect. The scope of applicants' claims read on patentable as well as unpatentable subject matter. This is particularly true when, for example, R<sub>1</sub>, R<sub>3</sub>, R<sup>5</sup>, R<sup>6</sup>, R<sup>7</sup>, R<sup>9</sup>, R<sup>10</sup>, X<sup>3</sup> are hydrogen, W<sub>2</sub> is a bond and Q is carbon. These particular derivatives are well-known in the art. However, the elected species and generically related species are otherwise allowable. Limitation of the scope of the invention should render the claims allowable.

3. No claim is allowed.
4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond Covington whose telephone number is (703)308-4704.

*re*  
Covington/LR

July 17, 2001

*Alan L. Rotman*  
ALAN L. ROTMAN  
PRIMARY EXAMINER